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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,696	09/28/2000	Joseph B. Sainton	0301.396	8478

7590 04/27/2004
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EXAMINER

TRINH, SONNY

ART UNIT PAPER NUMBER

2685

DATE MAILED: 04/27/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/670,696

Applicant(s)

SAINTON ET AL.

Examiner

Sonny TRINH

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32-106 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2,4,8,13.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 24-31 in Paper No. 12 is acknowledged.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 24 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,134,453 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Patent claim 24 of current application is similar in scope to claim 1 of the U.S. Patent No. 6,134,453, granted to Sainton et al., is **similar in scope** with wording variations only.

Limitations of **claim 24** of the pending application recites:

A multi-modal device for facilitating wireless communication over any one of a plurality of wireless communication networks at least some of which may be available and operating at a given time and location using differing radio frequency modulation protocols and over differing radio frequencies, comprising:

- a frequency agile radio transceiver capable of operating at any frequency or frequencies appropriate for each of the plurality of wireless communication networks, said frequency or frequencies selected in response to a frequency control signal;

- an interface circuit for interconnecting said frequency agile radio transceiver with an external signal circuit to allow signal information to be sent and received over said frequency agile radio transceiver;

- a protocol agile operating circuit for operating said frequency agile radio transceiver and said interface circuit in accordance with any one modulation protocol of a plurality of modulation protocols, said one modulation protocol selected in response to a protocol control signal;

- adaptive control circuit for determining which wireless communications networks are available at a given location and time, for accessing a selected wireless communication network, and for generating the frequency control signal and the protocol control signal in response to a user defined individual priority to cause the device to communicate with the selected wireless communication network using the frequencies and modulation protocol suitable for transmission of said signal information over said selected wireless communication network; and

input means for receiving and storing the user defined individual priority for selecting among the plurality of wireless communication networks and for allowing subsequent changes by the user of the stored user defined individual priority whenever desired by the user, said user defined individual priority defining which one of the wireless communication networks is accessed among the wireless communication networks that are determined by said adaptive control circuit to be available;

wherein said adaptive control circuit operates to generate said frequency control signal and said protocol control signal appropriate for the wireless communication network that is determined by said adaptive control means to be available and satisfies said user defined individual priority.

Above limitations of claim 24 are taught by claim 1 of Patent 6,134,453.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 24-25, 27-31** are rejected under 35 U.S.C. 102(e) as being anticipated by Bridges et al. ("Bridges"; U.S. Patent Number 6,148,197).

Regarding **claim 24**, Bridges teaches a multi-modal device for facilitating wireless communication over any one of a plurality of wireless communication networks at least some of which may be available and operating at a given time and location using differing radio frequency modulation protocols and over differing radio frequencies (abstract, column 2, specifically lines 18-37), comprising:

a frequency agile radio transceiver capable of operating at any frequency or frequencies appropriate for each of the plurality of wireless communication networks (inherent), said frequency or frequencies selected in response to a frequency control signal; an interface circuit for interconnecting said frequency agile radio transceiver with an external signal circuit to allow signal information to be sent and received over said frequency agile radio transceiver; a protocol agile operating circuit for operating said frequency agile radio transceiver and said interface circuit in accordance with any one modulation protocol of a plurality of modulation protocols, said one modulation protocol selected in response to a protocol control signal; adaptive control circuit for determining which wireless communications networks are available at a given location and time, for accessing a selected wireless communication network, and for generating the frequency control signal and the protocol control signal in response to a user defined individual priority to cause the device to communicate with the selected wireless communication network using the frequencies and modulation protocol suitable for transmission of said

signal information over said selected wireless communication network (columns 3-7); and input means for receiving and storing the user defined individual priority for selecting among the plurality of wireless communication networks and for allowing subsequent changes by the user of the stored user defined individual priority whenever desired by the user, said user defined individual priority defining which one of the wireless communication networks is accessed among the wireless communication networks that are determined by said adaptive control circuit to be available; wherein said adaptive control circuit operates to generate said frequency control signal and said protocol control signal appropriate for the wireless communication network that is determined by said adaptive control means to be available and satisfies said user defined individual priority (column 3, specifically lines 34-49, see figure 3 and description starting from column 12 line 8).

Regarding **claim 25**, Bridges teaches that the plurality of wireless communications network includes three or more wireless communication networks (such as cellular, PCS, and PCN, see column 2 line 52-67).

Regarding **claim 27**, modem means for modulating and/or demodulating a carrier signal with user data is inherent in a wireless telephone.

Regarding **claim 28**, data processor means for processing digital data sent and/or received over said frequency agile transceiver is inherent in a wireless telephone system of Bridges.

Regarding **claim 29**, since the mobile telephone system of Bridges can operate with different wireless carrier when the mobile station roams outside of a home area, it

is inherent that said protocol agile operating circuit means is adapted to cause said frequency agile transceiver to control telephone call placement and call answering functions over wireless communication networks having such telephone functions.

Regarding **claims 30-31**, these two claims merely reflect the software controlled (operating program and oscillator control for the transceiver) necessary for the operating of the wireless transceiver as specified in claim 24 and are therefore rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al. ("Bridges"; U.S. Patent Number 6,148,197) in view of Mueller et al. ("Mueller"; U.S. Patent Number 6,185,413).

Regarding **claim 26**, Bridges teaches the invention including the selection of the roaming charges (column 3 lines 50-63) but does not explicitly disclose that the adaptive control circuit is adapted to communicate in accordance with an electronic handshake with selected wireless communication networks to determine on a real time basis the cost for desired services from the corresponding wireless communication network.

In an analogous art, Mueller teaches a cost efficient method for managing communications services. Mueller further teaches that a control circuit is adapted to communicate in accordance with an electronic handshake with selected wireless communication networks to determine on a real time basis the cost for desired services from the corresponding wireless communication network (abstract, column 10 line 30 to column 11 line 14).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the cost effective method, as taught by Muller, to the system of Bridges, in order to save the cost of operating the mobile station by allowing the user to select the least cost possible. This combination is obvious because everyone likes to save money.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6th Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 703-305-

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1961. The examiner can normally be reached on Monday-Thursday and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed URBAN can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SONNY TRINH
PATENT EXAMINER

4/21/04